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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/836,561	04/16/2001	Olga Bandman	PF-0333-2 DIV	8070

7590

04/26/2002

INCYTE GENOMICS, INC.
PATENT DEPARTMENT
3160 Porter Drive
Palo Alto, CA 94304

EXAMINER

HUFF, SHEELA JITENDRA

ART UNIT

PAPER NUMBER

1642

DATE MAILED: 04/26/2002

5

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/836,561

Applicant(s)

BANDMAN ET AL.

Examiner

Sheela J Huff

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) ____ is/are pending in the application.
4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-27 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

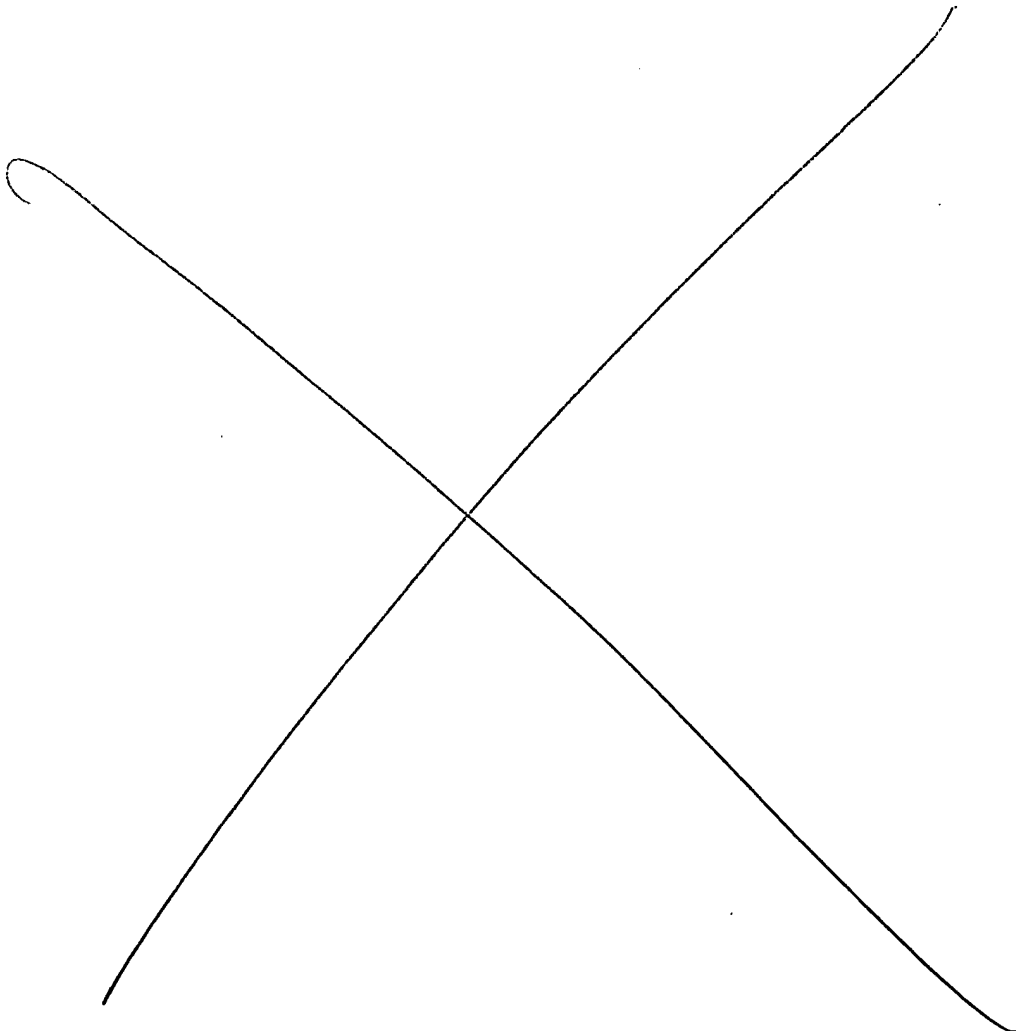
- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other: ____

- I. Claims 1-3 and 5-8 as they read on SEQ ID NO. 1, drawn to SEQ ID NO. 1 and compositions thereof, classified in class 530, subclass 350+.
- II. Claims 1-2 and 4-8 as they read on SEQ ID NO. 3, drawn to SEQ ID No. 3 and compositions thereof, classified in class 530, subclass 350.
- III. Claims 9-10 as they read on SEQ ID No. 1, drawn to methods for screening for antagonists/agonists (as they read on SEQ ID NO. 1), classified in class 435, subclass 4+.
- IV. Claims 9-10 as they read on SEQ ID No. 3, drawn to methods for screening for antagonists/agonists (as they read on SEQ ID NO. 3), classified in class 435, subclass 4+.
- V. Claims 11-19, 23-24 and 26 as they read on SEQ ID No. 1, drawn to antibodies directed to SEQ ID No. 1 and compositions comprising them, classified in class 530, subclass 187.1+
- VI. Claims 11-19, 23-24 and 26 as they read on SEQ ID No. 3, drawn to antibodies directed to SEQ ID No. 3 and compositions comprising them, classified in class 530, subclass 187.1+
- VII. Claim 20 (as it reads on SEQ ID NO. 1), drawn to a method of detecting a polypeptide using the antibody of claim 17, classified in class 435, subclass 7.1+.
- VIII. Claim 20 (as it reads on SEQ ID NO. 3), drawn to a method of detecting a polypeptide using the antibody of claim 17, classified in class 435, subclass 7.1+.

- IX. Claim 21 (as it reads on SEQ ID NO. 1), drawn to a method of purifying an antibody, classified in class 435, subclass 174+.
- X. Claim 21 (as it reads on SEQ ID NO. 3), drawn to a method of purifying an antibody, classified in class 435, subclass 174+.
- XI. Claims 22, 25 and 27 (as they read on SEQ ID NO. 1), drawn to a diagnostic test, classified in class 435, subclass 7.9+.
- XII. Claims 22, 25 and 27 (as they read on SEQ ID NO. 3), drawn to a diagnostic test, classified in class 435, subclass 7.9+.

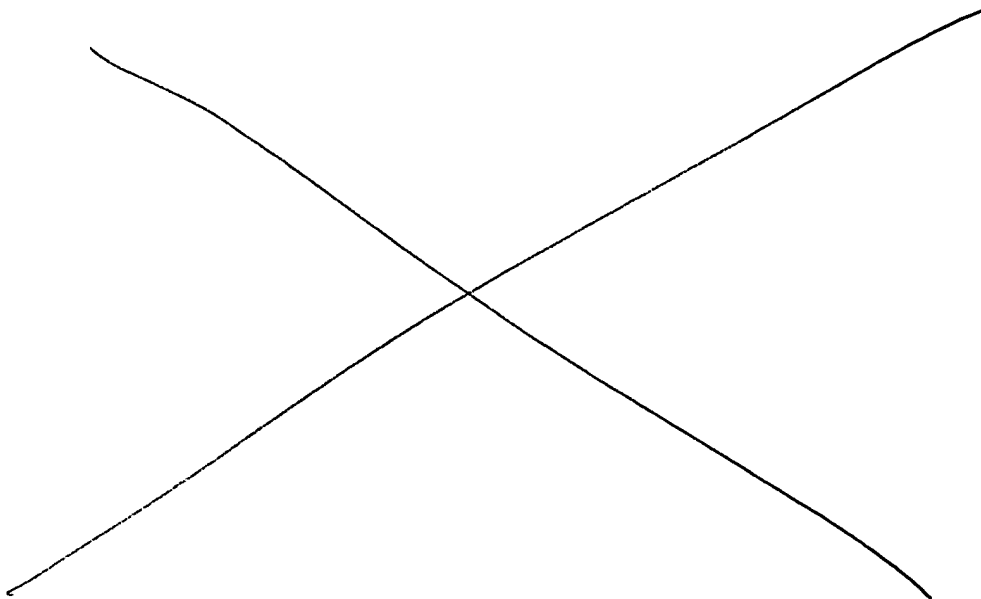


The inventions are distinct, each from the other because of the following reasons:

Inventions [I, III, V, VII, IX and XI] and [II, IV, VI, VIII, X and XII] are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together, or they have different modes of operation, or they have different functions, or they have different effects. (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are chemically and structurally different, in other words they are directed to different polypeptides.

Furthermore, inventions I and V are different because invention I is directed to a polypeptide and invention V is directed to an antibody. The protein can be used to make antibodies and in therapy and antibodies can be used in immunoassays, affinity purification etc. For the same reasons inventions VI and II are different.

Furthermore, inventions II-IV and VII-XII are different because they are directed to different methods they have different end results and use different reagents.



Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Due to the complexity of this restriction, a telephone call was not made to request an oral election to the above restriction requirement.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sheela J Huff whose telephone number is 703-305-7866. The examiner can normally be reached on M,Th 5:30 am-2:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa can be reached on 703-308-3995. The fax phone numbers for the organization where this application or proceeding is assigned are 703-

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308-4242 for regular communications and 703-308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.


Sheela J Huff
Primary Examiner
Art Unit 1642

sjh
April 25, 2002